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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,630	12/14/2001	William R. Matz	36968/265389	9447

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EXAMINER
OUELLETTE, JONATHAN P

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 08/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/017,630	Applicant(s) MATZ ET AL.
	Examiner Jonathan Ouellette	Art Unit 3629

-- The MAILING DATE of this communication appears on th cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 May 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17,19 and 20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17,19 and 20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *5* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Amendment

1. Claim 18 has been cancelled; therefore, Claims 1-17, 19 and 20 remain pending in application 10/017630.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> a. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1, 5, and 8-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawler (US 5,758,259) in view of ACTV (www.actv.com, Screen Print from internet archive wayback machine <www.archive.org>, Date Range: 5/10/2000-10/8/2000).

4. As per independent Claims 1, 12, and 16, Lawler discloses a method for providing a tailored media content comprising: analyzing a subscriber attribute in a subscriber database, wherein said subscriber database comprises a media-content-access history of said subscriber (Abstract); developing a media-content offering complementary to said subscriber attribute (C2 L25-30); and delivering said media-content offering to said subscriber (C2 L30-33).

(Abstract, Figs.3B-6, C1 L60-67, C2 L1-49, C5 L52-65, C7 L36-43, C9 L36-62, Claims 12-15).

5. Lawler fails to expressly disclose wherein said subscriber attribute comprises a demographic measure of said subscriber.

6. ACTV discloses software used with digital television systems called "Individual Television," in which the software is used for creating interactive and instantly customized television content and advertising in response to viewer remote control entries or to stored demographic information (www.actv.com).

7. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein said subscriber attribute comprises a demographic measure of said subscriber, as disclosed by ACTV in the system disclosed by Lawler, for the advantage of providing a method for providing a tailored media content, with the ability to tailor/target the media content to specific users based on a range of attributes, in order to increase user satisfaction by more accurately providing media content that matches users wants and needs.

8. As per Claim 5, Lawler and ACTV disclose wherein said step of developing said media-content offering comprises analyzing an existing media-content offering (Lawler: Abstract, Figs.3B-6, C1 L60-67, C2 L1-49, C5 L52-65, C7 L36-43, C9 L36-62, Claims 12-15).

9. As per Claims 8-10, 13, and 14, Lawler and ACTV fail to expressly disclose the steps of setting a price for said media-content offering, developing a direct marketing campaign complementary to said media-content offering, and developing an incentive plan

complementary to said media-content offering (Lawler: Abstract, Figs.3B-6, C1 L60-67, C2 L1-49, C5 L52-65, C7 L36-43, C9 L36-62, Claims 12-15).

10. However, these steps are obvious business strategies/techniques commonly used at the time the invention was made.

11. Furthermore, these steps can be accomplished completely through the use of the common business training/knowledge and require no additional apparatus described in the specification, which would have made the steps non-obvious to combine with the method described by Lawler, in order to create a method for providing a tailored media content, with the advantage of attracting customers using common business strategies/techniques.

12. As per Claims 11 and 15, Lawler and ACTV disclose creating a marketing bundle, wherein said marketing bundle comprises a said media-content offering and a product (Lawler: Abstract, Figs.3B-6, C1 L60-67, C2 L1-49, C5 L52-65, C7 L36-43, C9 L36-62, Claims 12-15).

13. Claims 2-4, 6, 7, 17, and 19-20 are rejected under 35 U.S.C. 103 as being unpatentable over Lawler in view of ACTV.

14. As per Claims 2, 3, and 17, neither Lawler nor ACTV expressly show wherein said attribute further comprises a purchase history of said subscriber.

15. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method for providing a tailored media content would be performed regardless of the type of attribute used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability,

see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

16. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the purchase history of said subscriber as an attribute in the method for providing a tailored media content, because such an attribute does not functionally relate to the steps in the method claimed and because the subjective interpretation of the attribute does not patentably distinguish the claimed invention.

17. As per Claims 4 and 19, neither Lawler nor ACTV expressly show wherein said media-content-access history comprises a subscriber content-choice database.

18. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method for providing a tailored media content would be performed regardless of the type of media-content-access history used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

19. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a subscriber content-choice database as a media-content-access history in the method for providing a tailored media content, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the media-content-access history does not patentably distinguish the claimed invention.

20. As per Claims 6, 7, and 20, neither Lawler nor ACTV expressly show wherein said step of delivering media-content offering comprises a television program or a television-programming package.

21. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method for providing a tailored media content would be performed regardless of the type of media-content offering used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

22. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a television program or a television-programming package as the media-content offering in the method for providing a tailored media content, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the media-content offering does not patentably distinguish the claimed invention.

Response to Arguments

23. Applicant's arguments filed 5/27/2003, with respect to Claims 1-17, 19 and 20, have been considered but are moot in view of the new ground(s) of rejection.

24. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

25. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

26. Additional Non-Patent Literature has been referenced on the PTO-892 form attached to the previous office action, and the Examiner suggests the applicant review these documents before submitting any amendments.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-0662. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.

28. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-3597 for After Final communications.

29. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

August 19, 2003

JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600